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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,184	03/14/2001	Kenji Ohshima	Q63509	2848

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12/04/2002

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,184

Applicant(s)

OHSHIMA ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 7-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, drawn to a sheet roll, classified in class 428, subclass 36.9.

II. Claims 7-17, drawn to a sheet roll discrimination device, classified in class 702, subclass 127.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility since it can be used as a sheet roll without the discrimination device of invention II. See MPEP § 806.05(d).

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Tracy Johnson on October 4, 2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-6, the limitation "target" is vague and indefinite. It is not understood what a "target" refers to. Whether a target is actually an object or just a section of the hollow portion. "Target" is determined to define any object within the hollow portion.

Regarding claims 5-6, the claims are indefinite because it is not understood if the "target position measuring device" or "target color measuring device" are part of the sheet roll or if the two devices are two completely different inventions. Also the claims are describing a process for using the target defined in claim 1, which receives little patentable weight in an article claim. Structure alone and not an intended use or a process defines articles. Therefore, claim 5 is determined to define a target that has a position within the hollow portion, and claim 6 is determined to define a target that has color.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nedstedt (USPN 4,620,184).

Nedstedt anticipates a sheet roll comprising a sheet rolled in a tubular manner to form a hollow portion therein (Fig. 2) and a target having a position in the hollow portion with a core tube or bobbin disposed in the hollow portion between the target and sheet roll. The target as determined to define any object within the hollow portion is determined to include a field-generating element, which is connected directly to the inside of the bobbin or may be supported by a mounting device located in the roll center or fixed centrally in the bobbin by means of a spring (col.2, 11.58-64). The target has an opening formed therein where an axle runs through it (Fig. 1).

7. Claims 1-2 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Lammers (USPN 5,984,049).

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Lammers anticipates a sheet roll comprising a sheet rolled in a tubular manner to form a hollow portion therein that is wound on a roll core (col.3, 11.10-13), and a target positioned in the core tube. The target as determined to define any object within the hollow portion is determined to include a signal-generating means, which is located inside an annular interspace between the roll core and a receptacle shaft of the unrolling means or dispenser device (col.2, 11.5-11). The signal-generating means or target has an opening formed therein for the acceptance arbor. The signal-generating means or target is represented by the conglomeration of reference numbers 6 and 6A-C in Figure 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for

establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nedstedt (USPN 4,620,184) in view of Adams et al (USPN 4,852,823).

Nedstedt teaches a sheet roll comprising a sheet rolled in a tubular manner to form a hollow portion with a core tube disposed in the hollow portion. Nedstedt does not explicitly teach a colored target. However, Adams et al teach a yarn tube with identification means, which is an insert or target, is shaped as a circular disc, which closely conforms to the outline of the circular shaped portion of the opening (col.3, ll.20-25). The insert does not protrude from the outer surface of the wall (col.3, ll.35-39). The insert is made in several different colors, to serve as an identification of the type of yarn (col.3, ll.40-47). The insert or target has an opening formed therein because the rotating spindles protrude into the yarn tube (Fig. 1). One of ordinary skill in the art would have

recognized that distinguishing the type of sheet roll is accomplished by similar identification means as distinguishing between rolls of yarn.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to add a colored target with an opening formed therein to Nedstedt in order to provide an identification or discrimination means for a sheet roll as taught by Adams et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Atwood (USPN 2,359,604); Thiele et al (USPN 4,883,178); Joyce (USPN 6,003,668).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 703-305-3440. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned

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are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB
November 27, 2002



HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/27/02